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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,759	10/15/2003	Steve Latham	119-0106	8693

7590 01/26/2005

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EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/686,759

Applicant(s)

LATHAM ET AL

Examiner

Marie Patterson

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-26 is/are allowed.
- 6) ☒ Claim(s) 1-19, 21, 27-29, 31 and 32 is/are rejected.
- 7) ☒ Claim(s) 20 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/15/03</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

***Claim Rejections - 35 USC § 112***

1. Claims 12-15, 28, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 13 and 28 the phrase "permanently attached" and in claims 14 and 29 the phrase "removably attached" are functional, vague, indefinite, and incomplete because they contain functional language not supported by recitation in the claim of sufficient structure to warrant the presence of such language. It is not clear what structural limitations applicant intends to encompass with such language.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 9-19, and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnold (5930920).

Arnold shows a shoe with a tool comprising a base (10), an aperture with slot (32), a closed slot (40), an alignment channel (12), a divot tool (plastic portion of element 70), and a stud (at 20) as claimed. In reference to claims 12-15, 28, and 29, the attachment of the base in Arnold is considered permanent (if a wearer never removes it from the shoe) or removable (if a user removes it) inasmuch as applicant has claimed such.

4. Claims 1-6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Dikoff (4535987).

Dikoff shows a tool comprising a base (12) with an aperture and slot (at 44), a closed slot (18 or 24), an alignment channel (shown at the bottom of element 12 in figure 1 as a half circle which aligns with 72), a divot tool (14) with a stud (62), a ball marker (38) with a stem (36), and a tapered base (shown at 56) as claimed.

5. Claims 9, 13-16 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Rowland (5209000).

Rowland shows a shoe with a base (10) attached to the upper of a shoe with an aperture (30) and slot (38) and an alignment channel (formed by 40 or between elements 26) inasmuch as applicant has claimed such.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dikoff in view of Hatch (3622157).

Dikoff shows a tool substantially as claimed except for the exact divot tool and the attachment of the ball marker. Hatch teaches providing a stud (22 or 41) on a divot tool for attaching a ball marker (26) thereon. It would have been obvious to provide a stud

and attach the ball marker as taught by Hatch in the tool of Dikoff to allow the user to attach an additional ball marker.

8. Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold.

Arnold shows a shoe with a blade thereon and states that the method of use is to wipe a golf club clean (as shown in figure 1) but does not clearly state which element, i.e. the club or the scraper are fixed during use. The specific method of motion/fixing of one element relative to the other appears to have no importance as Arnold does not specify one or the other. It would have been obvious to move either the club or the scraper and the presence of claims 31 and 32 is evidence that the invention is indifferent, i.e. there is no criticality, to the specific one of the obvious/conventional methods.

***Allowable Subject Matter***

9. Claims 22-26 are allowed.

10. Claims 20 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306

Art Unit: 3728

**(FORMAL FAXES ONLY).** Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.

A handwritten signature in black ink, appearing to read 'Marie Patterson', with a long, sweeping horizontal line extending to the right.

Marie Patterson  
Primary Examiner  
Art Unit 3728